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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,438	06/10/2002	Emanuelle Coignoul	KPTS/6648	6528

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 02/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,438

Applicant(s)

COIGNOUL ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11-31 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 11-31 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 12/27/2004. Applicants' amendments to the specification, claims 11, 20-23 and 26 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 11-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

More particularly, it is noted that each of the newly amended independent claims 11 and 26 now recites *inter alia* "wherein the foamed thermoplastic elastomer composition is oil-free", and Applicants have not pointed out any express or inherent

support, nor does the Examiner find a clear support in the specification for such amendment. As such, the amendments appear to be new matter, cancellation or support is required.

Additionally, it should be noted that "oil-free" is inherently equivalent to "free of oil", which is new matter under the rule of *Ex Parte Grasselli et al.* – Bd. of App. 231 PQ 393, Affd. 738 F. 2d 453 (Fed. Cir. 1984) to the effect that a limitation such as "free of" a particular element are new matter in the absence of express support.

Finally, it should be noted that Applicants disclosure of "plasticizers ... in the present formulation is only optional ..." (specification, page 9, lines 12-35) is not taken to be a teaching of "oil-free", because "plasticizer" is not "oil" in general.

### ***Rejections Based on Prior Art***

6. Claims 11-15 and 20-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (US 5496862) in view of Hwo (US 5585411), generally as set forth in sections 6 and 8 of Office action dated 9/22/2004, together with the following additional reasoning and response to argument.

First, it is noted that independent claim 1 has been amended to limit the "branched polyolefins" as "polymers having alkyl groups containing 2 or more carbon atoms attached to a carbon backbone".

With respect to Applicants' argument "Burns teaches including in the polymer blend 2 weight percent low density polypropylene, a compound that does not have alkyl groups having 2 or more carbon attached to the carbon backbone" (Remarks, page 7,

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4<sup>th</sup> paragraph), the Examiner notes that while Burns lacks a teaching of using a branched polymer having alkyl groups containing 2 or more carbon atoms attached to a carbon backbone, incorporating such a branched polymer is known art taught by Hwo. Specifically, the Examiner repeats (see prior Office action dated 9/22/2004, pages 6-7, bridging paragraph) that Hwo's invention is directed to a plastic foam produced from a blend comprising poly-1-butene and styrenic block copolymer. The foam has excellent tear resistance and flexibility properties (Abstract). Further, Hwo teaches that the poly-1-butene polymers have a melt flow in the range of from about 0.1 to 1500 (column 2, lines 11-12), and Hwo also expressly teaches an embodiment of a blend which comprises from about 65 wt % to about 90 wt % of poly-1-butene, and from about 10 to about 35 wt % of styrenic block or star copolymer (column 4, lines 32-36). As such, it would have been obvious to one of ordinary skill in the art of plastic foam to modify Burns styrenic block copolymer as a blend with poly-1-butene, motivated by the desire to obtain a bottle closure with improved tear resistance and flexibility. It should be noted inherently poly-1-butene is a polymer having alkyl groups containing 2 or more carbon atoms attached to a carbon backbone.

With respect to Applicants' argument "Hwo teaches poly-1-butene combined with minority components including star copolymers that are interchangeable with conjugated diene block copolymers, olefinic rubber, and a foaming agent for use as a material in demanding temperature tolerance applications" (Remarks, page 8, middle paragraph), the Examiner notes that Hwo's teaching that the blend of styrenic block copolymer poly-1-butene is suitable for high temperature application is irrelevant. It

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should be noted that the teachings of Burns and Hwo are combinable, because they are from the same field of endeavor, i.e., styrenic block copolymer blend, their combined teachings read on the instant invention as claimed, and Hwo teaches the use of the branched polymer to increase the benefit of properties Burns deems important, i.e., flexibility among others.

7. Claims 17-19 and 26-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (US 5496862) in view of Hwo (US 5585411), and further in view of Burnell (US 5727182), generally as set forth in sections 7 and 9 of Office action dated 9/22/2004, together with the following additional reasoning and response to argument.

First, it should be noted that in response to Applicants' amendment, the Examiner has modified the basis of rejection as relied upon the teachings of Burns in view of Hwo, and further in view of Burnell, as set forth above.

With respect to Applicants' argument "Burnell requires a hydrocarbon rubber extending oil in each composition of styrenic block copolymers" (Remarks, pages 7-8, bridging sentence), the Examiner notes that clearly Applicants are arguing the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. The Examiner asserts that the combined teachings of Burns in view of Hwo, and further in view Burnell show that hydrogenated and nonhydrogenated styrenic block copolymer are equivalent materials in making foams, as taught by Burnell.

Finally, with respect to Applicants' repeated arguments "Burns does not teach 10 to 100 parts by weight of a branched polyolefin selected from the group consisting of a polymer of 1-butene ... Burnell requires a hydrocarbon rubber extending oil ... Hwo teaches a material in demanding temperature tolerance ..." (Remarks, pages 8-9, bridging paragraph), the Examiner repeats (see Office action dated 9/22/2004) that claims 26-31 contain the same claimed elements of claims 1-25, as such they are also rejected for the same reasons as set forth above.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Victor S Chang  
Examiner  
Art Unit 1771

2/10/2005

  
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SUPERVISORY PATENT EXAMINER  
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